

or branched alkyl group having 1-4 carbon atoms and R<sup>9</sup> represents a hydrogen atom or a methyl group, and

(B) a photoacid generator.

30. The radiation-sensitive resin composition according to Claim 23, wherein R<sup>1</sup> in the formula (1) is a hydrogen atom and both X<sup>1</sup> and R<sup>2</sup> in the formula (1) are trifluoromethyl groups.

31. The radiation-sensitive resin composition according to Claim 24, wherein R<sup>1</sup> in the formula (1) is a hydrogen atom and both X<sup>1</sup> and R<sup>2</sup> in the formula (1) are trifluoromethyl groups.

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#### **REMARKS**

Claims 1-3 and 12-13 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over Claims 37 and 41-43 of copending U.S. Patent Application Serial No. 09/794,466 (Publication No. US 2002/0164538 A1), hereinafter the '466 application (pp. 2-3, numbered paragraph 5 of the Official Action).

The legal title of the instant application is different than the legal title to the '466 application. Accordingly, the filing of a terminal disclaimer is not appropriate. However, since all of the remaining rejections have been addressed in this response, it is respectfully requested that the provisional obviousness type double patenting rejection be withdrawn and the application be permitted to issue. See MPEP §804(I)(B). Reconsideration and withdrawal of the provisional obviousness type double patenting rejection of Claims 1-3 and 12-13 is therefore respectfully requested.

Claims 1-4, 12 and 15-16 were rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 6,503,686 to Fryd et al. (hereinafter referred to as "Fryd"). This rejection appears on pg. 4, numbered paragraph 8 of the Official Action. Claims 1-4 and 12-14

were rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent Application Serial No. 2002/0187419 A1 to Dammal et al. (hereinafter referred to as "Dammal"). This rejection appears on pp. 5-6, numbered paragraph 9 of the Official Action. Claims 1-3 and 12-16 were rejected under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent Publication No. 2002/0164538 A1 (based on U.S. Patent Application Serial No. 09/794466) to Allen et al. (hereinafter referred to as "Allen"). This rejection appears on pg. 6, numbered paragraph 10 of the Official Action. Claims 5-7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Dammal as applied to Claims 1-4 and 12-14 above. This rejection appears on pp. 7-8, numbered paragraph 13 of the Official Action. Claims 15-16 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Dammal as applied to Claims 1-4 and 12-14 above and in further view of U.S. Patent No. 6,165,678 A1 to Allen et al. This rejection appears on pp. 8-9, numbered paragraph 14 of the Official Action. Claims 1-7 and 9-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over US 2002/0004569 A1 to Hatakeyama et al. (hereinafter referred to as "Hatakeyama"). This rejection appears on pp. 9-11, numbered paragraph 15 of the Official Action.

Fryd is an issued U.S. Patent which was filed as U.S. Patent Application Serial No. 09/714,782 on November 16, 2000. Therefore, Fryd is available as a reference under 35 U.S.C. 102(e)(2) as of the filing date of the '782 application (i.e., November 16, 2000). Dammal is a U.S. Patent Application Publication of U.S. Patent Application Serial No. 09/853,732 which was filed on May 11, 2001. Dammal has a publication date of December 12, 2002. Therefore, the earliest date that Dammal is available as a reference {i.e., under 35 U.S.C. 102(e)(1)} is the filing date of the '732 application (i.e., May 11, 2001). Allen is a U.S. Patent Application Publication of U.S. Patent Application Serial No. 09/794,466 which was filed on February 26, 2001. Allen has a publication date of November 7, 2002. Therefore, the earliest date that Allen is available as

a reference {i.e., under 35 U.S.C. 102(e)(1)} is the filing date of the '466 application (i.e., February 26, 2001). Hatakeyama is a U.S. Patent Application Publication of U.S. Patent Application Serial No. 09/842,114 which was filed on April 26, 2001. Hatakeyama has a publication date of January 10, 2002. Therefore, the earliest date that Hatakeyama is only available as a reference {i.e., under 35 U.S.C. 102(e)(1)} as of the filing date of the '114 application (i.e., April 26, 2001).

The Applicants, however, have claimed priority to JP 182297/2000, which was filed on June 16, 2000. Submission of a certified English translation of applicant's JP 182297/2000 priority document would therefore remove each of Fryd, Dammel, Allen and Hatakeyama as prior art. See MPEP §706.02(b). Accordingly, a certified English translation of the Applicant's Japanese priority document JP 182297/2000 is being filed herewith. Since the foreign priority filing date (i.e. June 16, 2000) is before the date at which any of Fryd, Dammel, Allen or Hatakeyama is available as prior art under 35 U.S.C. §102(e) and since this foreign priority claim has been perfected by the filing of a certified English translation of the priority document, it is respectfully submitted that these rejections have been overcome. Accordingly, reconsideration and withdrawal of the above rejections involving Fryd, Dammel, Allen or Hatakeyama is respectfully requested.

Claims 1-3 and 12-13 were rejected under 35 U.S.C. §102(f) because the applicant allegedly did not invent the claimed subject matter. According to the Official Action, the claimed subject matter of the present application is allegedly rendered obvious by copending U.S. Patent Application Serial No. 09/794,466 (U.S. Patent Publication No. 2002/0164538) to Allen et al. This rejection, which appears on pg. 7, numbered paragraph 11 of the Official Action, is respectfully traversed for the following reasons.

Submitted herewith is a Declaration made under 37 C.F.R. §1.132 executed by the inventor commonly named in both the instant application and the '466 application (i.e., Hiroshi Ito). This Declaration clearly establishes that Hiroshi Ito was the sole inventor of the subject matter claimed in the instant application to the extent that this subject matter is also disclosed and claimed in the '466 application. This Declaration also clearly establishes that the additional inventors listed on the '466 application did not invent subject matter claimed in the instant application and that the additional inventors listed on the instant application did, in fact, invent subject matter claimed in the instant application. It is respectfully submitted that the attached Declaration under 37 C.F.R. §1.132 clearly establishes that the presently named inventors are the actual inventors of the subject matter disclosed and claimed in the instant application. Reconsideration and withdrawal of this rejection is therefore respectfully requested.

New Claims 17-31 have been added. These claims are patentable over the cited references for at least the reasons set forth above with respect to Claim 1.

### **CONCLUSION**

All rejections having been addressed by the present amendments and response, Applicants believe that the present case is in condition for allowance and respectfully request early notice to

that effect. If any issues remain to be addressed in this matter which might be resolved by discussion, the Examiner is respectfully requested to call Applicants' undersigned counsel at the number indicated below.

Respectfully submitted,

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